

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Vroon

Appeal No. _____
Application No. 10/761,013

APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	William J. Vroon	Art Unit:	3781
Serial No.:	10/761,013	Examiner:	Harry A. Grosso
Filed:	January 20, 2004	Atty. Docket No.:	BRP-204
For:	LIGHTWEIGHT STACKABLE HORIZONTAL DISPENSING CONTAINER		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEFI. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee, Bradford Company, 13500 Quincy Street, P.O. Box 1199, Holland, Michigan 49422-1199.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-6, 9-10, 12-13, 15-19, 24-25, 27, 36-37 and 45-62 are pending in the application. Claims 1-4, 6, 9-10, 12, 15-17, 19, 24-25, 27, 36-37 and 45-62 stand rejected, and are now on appeal. Claims 5, 13 and 18 stand withdrawn from consideration. Claims 7-8, 11, 14, 20-23, 26, 28-35 and 38-44 have been cancelled.

IV. STATUS OF AMENDMENTS

Amendments have been filed subsequent to the final rejection and entered in an Advisory Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As recited in independent claim 1, the present invention is generally directed to a stackable horizontal dispensing container as shown in Fig. 4 comprising a pallet base 42b, a pallet cover 44b and a three sided sleeve 46b, fasteners 45 as shown in Fig. 3 and a rectangular frame 48 having an open interior 84 as shown in Fig. 3. See specification, page 23, lines 14 to page 24, line 2 and page 16, line 11 to page 18, line 9. The stackable horizontal dispensing container as shown in Fig. 4 is the same container shown in Fig. 3 but with different dunnage. See page 23, lines 14-16. The three sided sleeve 46b is made of corrugated plastic having vertically oriented corrugations 72, the sleeve 46b extending between the pallet base 42b and pallet cover 44b. See Figs. 3, 3A and 4 and specification, page 18, lines 10-12. The sleeve 46b, pallet base 42b and pallet cover 44b define an interior of the horizontal dispensing container. See Figs. 3 and 4. The fasteners 45 shown in Fig. 3 extend through a portion of the sleeve 46b to secure the sleeve 46b to the pallet base 42b. See specification, page 19, line 21 to page 20, line 4. The rectangular frame 48 having an open interior 84 (as shown in Fig. 3) is secured to opposed sides 64 of the sleeve 46 such that the rectangular frame 48 defines an opening on a fourth side of the horizontal dispensing container 40. See specification, page 19, lines 10 to 20.

As shown in Fig. 3, the horizontal dispensing container 40 further comprises dunnage 88 comprising intersecting partitions 90, 92 inside the interior of the container 40. See specification, page 20, lines 5-19. Alternatively, the dunnage inside the container may comprise pouches 100 as shown in Fig. 4. See specification, page 23, line 12 to page 24, line 2 and Fig. 4.

As recited in independent claim 16, the stackable horizontal dispensing container as shown in Fig. 4 comprises a pallet base 42b, a three sided sleeve 46b made of corrugated plastic having vertically oriented corrugations 72 defining a plurality of flutes 74. See Figs. 3, 3A and 4 and page 18, lines 10-12. The sleeve 46b is secured to the pallet base 42b with fasteners 45 extending through the flutes 74 of the sleeve 46b. See Figs. 3, 3A and 4. See page 19, line 21 to page 20, line 4. The stackable horizontal dispensing container as shown in Fig. 4 further comprises a frame 48 having an open interior 84 and secured to opposed sides 64 of the sleeve 46 such that the rectangular frame 48 defines an opening on a fourth side of the horizontal dispensing container 40 whereby the container provides horizontal access to product residing in the interior of the container. See specification, page 19, lines 10 to 20 and page 21, lines 16-23 and Figs 3 and 4.

As recited in independent claim 36, the stackable horizontal dispensing container comprises a pallet base 42b having a lip 54 extending upwardly from a body 43 of the pallet base 42b. See page 16, line 23 to page 17, line 5 and Figs. 3 and 4. The stackable horizontal dispensing container further comprises a pallet cover 42b having a lip 60 extending downwardly from a body 61 of the pallet cover 44b. See page 17, lines 13 to 19 and Figs. 3 and 4. The stackable horizontal dispensing container further comprises a three sided sleeve 46b extending

between the pallet base 42b and pallet cover 44b. See Figs. 3, 3A and 4 and page 7, lines 8-16 and page 18, lines 1-9. At least two sides of the sleeve 46b are inside the lips of the pallet base 42b and pallet cover 44b. See Figs. 3, 3A and 4 and specification, page 9, lines 11-12. The stackable horizontal dispensing container further comprises a rectangular frame 48 secured to opposed sides 64 of the sleeve 46 such that the rectangular frame 48 defines an opening on a fourth side of the horizontal dispensing container 40. See specification, page 19, lines 10 to 20 and page 21, lines 16-23 and Figs 3 and 4.

As recited in independent claim 46, the stackable horizontal dispensing container comprises a pallet base 42b, a pallet cover 44b and a sleeve 46b made of corrugated plastic extending between the pallet base 42b and pallet cover 44b. See Figs. 3, 3A and 4 and page 18, lines 10-12. The sleeve 46b, pallet base 42b and pallet cover 44b define an interior of the horizontal dispensing container wherein the corrugations extend vertically. See page 18, lines 10-12 and Figs. 3, 3A and 4. The stackable horizontal dispensing container further comprises fasteners 45 shown in Fig. 3 extending through a portion of the sleeve 46b and securing the pallet base 42b to the sleeve 46b. See specification, page 19, line 21 to page 20, line 4. The stackable horizontal dispensing container further comprises a rectangular frame 48 secured to opposed sides 64 of the sleeve 46 such that the rectangular frame 48 defines an opening on a fourth side of the horizontal dispensing container 40. See specification, page 19, lines 10 to 20.

As recited in independent claim 51, the stackable horizontal dispensing container comprises a pallet base 42b, a sleeve 46b made at least partially of corrugated plastic wherein the corrugations extend vertically. See Figs. 3, 3A and 4 and page 18, lines 10-12. The stackable

horizontal dispensing container further comprises a brace 140 extending between opposed sides of the sleeve 46b. See page 12, lines 7-11 and Figs. 6 and 7. The stackable horizontal dispensing container further comprises fasteners 45 shown in Fig. 3 extending through a portion of the sleeve 46b and the brace 140 for securing the pallet base 42b, the sleeve 46b and the brace 140 together. See specification, page 28, lines 3 - 13 and page 12, lines 7-11. The stackable horizontal dispensing container further comprises a rectangular frame 48 having an open interior 84 secured to opposed sides 64 of the sleeve 46 such that the rectangular frame 48 defines an opening on a fourth side of the horizontal dispensing container 40. See specification, page 19, lines 10 to 20.

As recited in independent claim 56, the stackable horizontal dispensing container comprises a pallet base 42b, a sleeve 46b made at least partially of corrugated plastic having vertically extending corrugations 72 defining a plurality of flutes 74, the sleeve 46b being secured to the pallet base 42b with fasteners 45 extending through the flutes of the sleeve 46b. See Figs. 3, 3A and 4 and page 18, lines 10-18 and page 19, lines 23-24. The stackable horizontal dispensing container further comprises a frame 48 secured to opposed sides 64 of the sleeve 46 the frame 48 defining an opening on a fourth side of the horizontal dispensing container 40 whereby the frame 48 has an open interior 84 to provide horizontal access to product residing in the interior of the container. See page 19, lines 10 to 20 and page 21, lines 16-23 and Figs 3 and 4.

As recited in independent claim 61, the stackable horizontal dispensing container comprises a pallet base 42b, a sleeve 46b made at least partially of corrugated plastic having vertically extending corrugations 72 defining a plurality of flutes 74, the sleeve 46b being

secured to the pallet base 42b with fasteners 45 extending through the flutes of the sleeve 46b. See Figs. 3, 3A and 4 and page 18, lines 10-18 and page 19, lines 23-24. The stackable horizontal dispensing container further comprises a metal frame 48 secured to opposed sides 64 of the sleeve 46 with fasteners 86. See page 19, lines 10-20 and Fig. 3. The metal frame 48 defines an opening on a fourth side of the horizontal dispensing container 40 whereby the frame 48 has an open interior 84 to provide horizontal access to product residing in the interior of the container. See page 19, lines 10 to 20 and page 21, lines 16-23 and Figs 3 and 4.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,725,118 (hereinafter *Slager et al.*) in view of U.S. Patent No. 4,828,132 (hereinafter *Francis Jr. et al.*) and U.S. Patent No. 1,163,696 (hereinafter *Silberman*) and U.S. Patent No. 4,172,623 (hereinafter *Anderson*).

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* as modified by *Francis Jr. et al.*, *Silberman*, and *Anderson* as applied to claim 1, and in further view of U.S. Patent No. 4,610,286 (hereinafter *Budowski et al.*).

Claims 6, 19, 50, 54 and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* as modified by *Francis Jr. et al.*, *Silberman*, and *Anderson* and in further view of U.S. Patent No. 6,540,096 (hereinafter *Bazany et al.*).

Claims 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* as modified by *Francis Jr. et al.*

VII. ARGUMENT

Rejection of Claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 Under 35 U.S.C. § 103(a)

Claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* in view of *Francis Jr. et al.* and *Silberman and Anderson*. The Examiner contends that *Slager et al.* discloses a stackable horizontal dispensing container with a pallet base (12), a pallet cover (16) and a three sided sleeve that is removably secured to the base and cover.

Slager et al. fails to teach a three sided sleeve at all, let alone one made of corrugated plastic material with vertically oriented corrugations. Fig. 3 of *Slager et al.* discloses a container 70 having a base 12, three injection molded plastic sidewalls 77a, 77b and 77c hinged to the base 12 and a removable cover 16. As stated in column 6, lines 32-35, the base 12 and side walls 14a, 14b and removable cover 16 of the first embodiment shown in Figs. 1 and 2 of *Slager et al.* are made of injection molded plastic.

The Examiner relies on *Francis Jr. et al.* for teaching constructing a container from corrugated plastic having vertically oriented corrugations. The Examiner states in the final Office Action that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of corrugated plastic panels as disclosed by *Francis Jr. et*

al. in the *Slager et al.* container because the use of corrugated material provides increased resistance to bending. Applicant disagrees with this rejection for the reasons set forth below.

Slager et al., even as modified by *Francis Jr. et al.*, fails to teach fasteners extending through the pallet base, pallet cover and sleeve. *Silberman* discloses a collapsible metal box having sides 10 and 11 having hooked overturned interlocking edges 12 and 13. The sides 10 and 11 have hooked overturned edges which form channels through which pass rods or bars 14 having a head 15 at one end and being threaded at the other end to receive a nut 17. As stated in column 2, lines 66-71 of *Silberman*, the rods or bars 14 passing through the channels formed in the overturned edges of the sides and the corner pieces of the lids bind all the parts together and reinforce the box against impact. The Examiner states in the final Office Action that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of fasteners extending through the pallet base, cover and sleeve as disclosed by *Silberman* in the modified *Slager et al.* container to provide a container that is strong and rigid. Applicant disagrees with this rejection for the reasons set forth below.

Regarding independent claim 1 and dependent claims 3, 4, 10 and 15 along with independent claim 46 and dependent claims 47-50, none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through a portion of a three sided sleeve to secure the sleeve to a pallet base. An examiner may not ignore a limitation which is absent from the references used in an obviousness rejection. In re Fine, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignored this limitation; *Silberman* does not disclose or teach it.

Regarding independent claim 16 and dependent claims 17, 24, 25, 27 and 45 along with independent claim 56 and dependent claims 57-60 and independent claim 61 and dependent claim 62, none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through flutes of a three sided sleeve made of corrugated plastic to secure the sleeve to a pallet base. An examiner may not ignore a limitation which is absent from the references used in an obviousness rejection. In re Fine, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignored this limitation; *Silberman* does not disclose or teach it.

Regarding independent claim 51 and dependent claims 52-55, none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through a portion of a three sided sleeve and through a brace extending between opposed sides of the sleeve to secure the pallet base, sleeve and brace together. An examiner may not ignore a limitation which is absent from the references used in an obviousness rejection. In re Fine, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignored this limitation; *Silberman* does not disclose or teach it.

Silberman actually teaches away from the claimed invention. If one were to incorporate fasteners extending through a portion of side walls of the *Slager et al.* container shown in Fig. 3, it would destroy one purpose of the *Slager et al.* container, to be able to remove the side walls. As stated in column 2, lines 40-43 of *Slager et al.*, the *Slager et al.* container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the

container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is clearly shown in Fig. 3 of *Slager et al.* Thus, it is illogical to modify the *Slager et al.* container shown in Fig. 3 to add fasteners extending through a portion of side walls as the Examiner suggests in his obviousness rejection. When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Without a suggestion or motivation to add fasteners to the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

Slager et al. , even as modified by *Francis Jr. et al.* and *Silberman*, fails to teach a rectangular frame with an open interior. *Anderson* discloses a cabinet 10 having a front frame 11 and a rear frame 12. The Examiner states in the final Office Action that with regards to claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of a frame as disclosed by *Anderson* in the modified *Slager et al.* container to provide rigidity to the container. Applicant disagrees with this rejection for the reasons set forth below.

If one were to incorporate the *Anderson* frame into the front of the *Slager et al.* container shown in Fig. 3 of *Slager et al.*, it would destroy the purpose of the *Slager et al.*

container. The frame of *Anderson* would have, in fact, destroyed several purposes of the invention of *Slager et al.* As stated in column 2, lines 40-43 of *Slager et al.*, the *Slager et al.* container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is clearly shown in Fig. 3 of *Slager et al.* Thus, it is impossible to modify the alternative embodiment of *Slager et al.* shown in Fig. 3 to add a frame as the Examiner suggests in his obviousness rejection.

A second purpose of the *Slager et al.* container shown in Figs. 1 and 3 and described from column 6, line 63 to column 7, line 1 is to keep the product grids 30, 42 from shifting inside the container body in the direction of the open sides 18, 19. To accomplish this, the side walls 14a, 14b have wrap around segments with lateral edges 59 which engage the adjacent grid portions 60. The same is true of the product grid 72 in the embodiment shown in Fig. 3. Due to the presence of these wrap around segments of side walls 14a, 14b in the *Slager et al.* container, there would have been no need to add a frame to the *Slager et al.* container.

When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Otetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01

(citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Without a suggestion or motivation to add a frame to the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

The Examiner has not established a prima facie case of obviousness in his rejection of claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. *See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999).

In this case, there is no teaching, suggestion or inference of modifying the *Slager et al.* container to incorporate corrugated plastic panels in place of the injection molded side walls of *Slager et al.* Secondly, there is no teaching, suggestion or inference of modifying the *Slager et al.* container to incorporate fasteners extending through the side walls to secure the pallet base to the side walls. Third, there is no teaching, suggestion or inference of modifying the *Slager et al.* container to incorporate a frame defining a horizontal opening of the container.

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

The Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Slager et al.* in view of *Francis Jr. et al.* and *Silberman and Anderson* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render the invention obvious. As such, the Examiner has failed to make a *prima facie* case of obviousness. Accordingly, claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 are patentable over *Slager et al.* in view of *Francis Jr. et al.* and *Silberman and Anderson*.

Rejection of Claim 2 Under 35 U.S.C. § 103(a)

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* in view of *Francis Jr. et al.*, *Silberman and Anderson* and *Budowski et al.*. The Examiner contends that *Slager et al.* in view of *Francis Jr. et al.*, *Silberman and Anderson* discloses the invention of claim 2 except for the sleeve being made of one piece of material. The Examiner further contends that *Budowski et al.* discloses a horizontal dispensing container with a sleeve made of one piece of material and that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of a sleeve made of one piece of material as disclosed by *Budowski et al.* in the *Slager et al.* container, as modified, to provide a tighter, more stable container and simplify assembly. Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 1 because claim 2 depends from claim 1.

In addition, *Budowski et al.* is directed to non-analogous art; it has nothing to do with shipping containers. A reference which is not directed to analogous art has no bearing on the obviousness of a patent claim under 35 U.S.C. §103. Jergens v. McKenzie, 927 F.2d 1152 (Fed. Cir. 1991).

Budowski et al. teaches away from the *Budowski et al.* container. *Slager et al.* discloses a container with two injection molded plastic sidewalls 14a, 14b, as well as additional sidewalls 14c, 14d which may be added, each sidewall being hinged to the base 12. See *Slager et al.* column 7, lines 10-27. A sleeve made of one piece of material like the one shown in *Budowski et al.* could not be used with the *Slager et al.* container because the sidewalls 14c, 14d of *Slager et al.* could not be removed from the container. Therefore, if one were to incorporate a one piece sleeve into the *Slager et al.* container, it would destroy one purpose of the *Slager et al.* container, the ability to retrofit the *Slager et al.* container to a shipping container having four sidewalls and vertical access through a top opening. See column 2, lines 40-43 of *Slager et al.* As described in column 7, lines 12-26 of *Slager et al.*, the base 12 of *Slager et al.* has a hinge structure 62 for securing additional sidewalls to the base 12 to form a four sided container. Such a hinge structure 62 is shown in Fig. 3 of *Slager et al.* Thus, it would be impossible to modify the *Slager et al.* container to have a one piece sleeve.

When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose,

there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984)). Without a suggestion or motivation to add a frame to a one piece sleeve of the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

Rejection of Claims 6, 19, 50, 54 and 59 Under 35 U.S.C. § 103(a)

Claims 6, 19, 50, 54 and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* in view of *Francis Jr. et al.*, *Silberman* and *Anderson* and further in view of *Bazany et al.* The Examiner contends that *Slager et al.* in view of *Francis Jr. et al.*, *Silberman* and *Anderson* discloses the invention of claims 6, 19, 50, 54 and 59 except for the use of pouches as dunnage. The Examiner further contends that *Bazany et al.* discloses a horizontal dispensing container with pouches for dunnage and that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of pouches for dunnage as disclosed by *Bazany et al.* in the *Slager et al.* container, as modified, because it is known in the art to use pouches for transporting items such as auto parts in this type of container.

Regarding claim 6, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 1 and dependent claim 4 because claim 6 depends from claim 4 which depends from independent claim 1.

Regarding claim 19, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 16 and dependent claim 17 because claim 19 depends from claim 17 which depends from independent claim 16.

Regarding claim 50, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 46 and dependent claim 48 because claim 50 depends from claim 48 which depends from independent claim 46.

Regarding claim 54, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 51 and dependent claim 52 because claim 54 depends from claim 52 which depends from independent claim 51.

Regarding claim 59, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 56 and dependent claim 57 because claim 59 depends from claim 57 which depends from independent claim 56.

Again, the Examiner's rejection destroys the purpose of the primary reference *Slager et al.*, even as modified. The *Slager et al.* container is specifically designed to hold in product receiving grids as described above. To modify the *Slager et al.* container to replace these grids with pouches would destroy the purpose of the *Slager et al.* container. See *Slager et al.* column 2, lines 47-55. The *Slager et al.* container may not be modified to incorporate pouches in place of product grids.

When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed

modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Without a suggestion or motivation to replace the grids of the *Slager et al.* container with pouches, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

The Examiner has not established a prima facie case of obviousness in this rejection. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See e.g. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ

929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

The Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Slager et al.* in view of *Francis Jr. et al.*, *Silberman* and *Anderson* and further in view of *Bazany et al.* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render

the invention obvious. As such, the Examiner has failed to make a *prima facie* case of obviousness.

Rejection of Claims 36 and 37 Under 35 U.S.C. § 103(a)

Claims 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Slager et al.* in view of *Francis Jr. et al.* The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of lips on the pallet base and pallet cover as disclosed by *Francis Jr. et al.* in the *Slager et al.* container to restrain the sleeve against expansion.

Again, the Examiner has not established a *prima facie* case of obviousness in this rejection. The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a *prima facie* case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a *prima facie* case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill

in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See e.g. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Slager et al.* in view of *Francis Jr. et al.* to yield the claimed combination. As discussed above, it is improper to use the claimed invention as a template for

modifying a reference in order to render the invention obvious. As such, the Examiner has failed to make a *prima facie* case of obviousness. Even when combined the three references do not anticipate or meet all of the limitations of claims 36 and 37.

VIII. CONCLUSION

In conclusion, applicants respectfully request that the Board reverse the Examiner's rejections of claims 1-4, 6, 9-10, 12, 15-17, 19, 24-25, 27, 36-37 and 45-62 and that the application be passed to issue. If there are any questions regarding the foregoing, please contact the undersigned at 513-241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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Date: August 31, 2007

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IX. CLAIMS APPENDIX: CLAIMS ON APPEAL (S/N 10/761,013)

Claim 1. (Previously Presented) A stackable horizontal dispensing container comprising:

a pallet base;

a pallet cover;

a three sided sleeve being made of corrugated plastic having vertically oriented corrugations, the sleeve extending between the pallet base and the pallet cover, the sleeve, pallet base and pallet cover defining an interior of the horizontal dispensing container;

fasteners extending through a portion of the sleeve to secure the sleeve to the pallet base; and

a rectangular frame having an open interior secured to opposed sides of the sleeve such that the rectangular frame defines an opening on a fourth side of the horizontal dispensing container.

Claim 2. (Original) The horizontal dispensing container of claim 1 wherein the sleeve is made of one piece of material.

Claim 3. (Original) The horizontal dispensing container of claim 1 wherein the sleeve is made of multiple pieces of material joined together.

Claim 4. (Original) The horizontal dispensing container of claim 1 further comprising dunnage inside the interior of the horizontal dispensing container.

Claims Appendix : Claims on Appeal 10/761,013

Claim 5. (Withdrawn) The horizontal dispensing container of claim 4 wherein the dunnage comprises intersecting partitions.

Claim 6. (Original) The horizontal dispensing container of claim 4 wherein the dunnage comprises pouches.

Claims 7-8. (Cancelled)

Claim 9. (Previously Presented) The horizontal dispensing container of claim 1 wherein the rectangular frame is secured to the sleeve with fasteners.

Claim 10. (Previously Presented) The horizontal dispensing container of claim 1 wherein the frame is made of metal to provide rigidity to the container.

Claim 11. (Cancelled)

Claim 12. (Previously Presented) The horizontal dispensing container of claim 1 wherein a second pallet base substantially identical to the pallet base may be stacked on the pallet cover.

Claim 13. (Withdrawn) The horizontal dispensing container of claim 1 further comprising a brace extending between opposed sides of the sleeve.

Claim 14. (Cancelled)

Claim 15. (Original) The horizontal dispensing container of claim 1 wherein the sleeve is less than twenty millimeters thick.

Claim 16. (Previously Presented) A stackable horizontal dispensing container comprising:
a pallet base;

a three sided sleeve made of corrugated plastic having vertically extending corrugations defining a plurality of flutes, the sleeve being secured to the pallet base with fasteners extending through the flutes of the sleeve; and

a frame having an open interior secured to opposed sides of the sleeve, the frame defining an opening on a fourth side of the horizontal dispensing container, whereby the container provides horizontal access to product residing in the interior of the container.

Claim 17. (Original) The horizontal dispensing container of claim 16 further comprising dunnage inside the interior of the horizontal dispensing container.

Claim 18. (Withdrawn) The horizontal dispensing container of claim 17 wherein the dunnage comprises intersecting partitions.

Claim 19. (Original) The horizontal dispensing container of claim 17 wherein the dunnage comprises pouches.

Claims 20-23. (Cancelled)

Claim 24. (Previously Presented) The horizontal dispensing container of claim 16 wherein the frame is rectangular.

Claim 25. (Previously Presented) The horizontal dispensing container of claim 16 wherein the frame is made of metal.

Claim 26. (Cancelled)

Claim 27. (Previously Presented) The horizontal dispensing container of claim 16 wherein the frame is secured to the sleeve with fasteners.

Claims 28-35. (Cancelled)

Claim 36. (Original) A stackable horizontal dispensing container comprising:
a pallet base having a lip extending upwardly from a body of the pallet base;
a pallet cover having a lip extending downwardly from a body of the pallet cover;

a three sided sleeve extending between the pallet base and the pallet cover, at least two sides of said sleeve being inside said lips of said pallet base and pallet cover;

a rectangular frame secured to opposed sides of the sleeve such that the rectangular frame defines an opening on a fourth side of the horizontal dispensing container.

Claim 37. (Original) The stackable horizontal dispensing container of claim 36 further comprising dunnage inside an interior of the horizontal dispensing container defined by the sleeve, pallet base and pallet cover.

Claims 38-44. (Cancelled)

Claim 45. (Previously Presented) The horizontal dispensing container of claim 16 further comprising a brace extending between opposed sides of the sleeve.

Claim 46. (Previously Presented) A stackable horizontal dispensing container comprising:

a pallet base;

a pallet cover;

a sleeve made of corrugated plastic and extending between the pallet base and the pallet cover, the sleeve, pallet base and pallet cover defining an interior of the horizontal dispensing container wherein the corrugations extend vertically;

fasteners extending through a portion of the sleeve and securing the pallet base to

the sleeve;

a rectangular frame secured to opposed sides of the sleeve with fasteners such that the rectangular frame defines an opening on a fourth side of the horizontal dispensing container.

Claim 47. (Currently Amended) The horizontal dispensing container of claim [[45]] 46 further comprising a brace extending between opposed sides of the sleeve.

Claim 48. (Currently Amended) The horizontal dispensing container of claim [[45]] 46 further comprising dunnage inside the container.

Claim 49. (Previously Presented) The horizontal dispensing container of claim 48 wherein the dunnage comprises intersecting partitions.

Claim 50. (Previously Presented) The horizontal dispensing container of claim 48 wherein the dunnage comprises pouches.

Claim 51. (Previously Presented) A stackable horizontal dispensing container comprising:

a pallet base;

a sleeve made at least partially of corrugated plastic wherein the corrugations extend vertically;

a brace extending between opposed sides of the sleeve;

fasteners extending through a portion of the sleeve and the brace for securing the pallet base, the sleeve and the brace together;

a rectangular frame having an open interior secured to opposed sides of the sleeve such that the rectangular frame defines an opening on a side of the horizontal dispensing container.

Claim 52. (Previously Presented) The horizontal dispensing container of claim 51 further comprising dunnage inside the container.

Claim 53. (Previously Presented) The horizontal dispensing container of claim 52 wherein the dunnage comprises intersecting partitions.

Claim 54. (Previously Presented) The horizontal dispensing container of claim 52 wherein the dunnage comprises pouches.

Claim 55. (Previously Presented) The horizontal dispensing container of claim 51 further comprising a pallet cover.

Claim 56. (Previously Presented) A stackable horizontal dispensing container comprising:
a pallet base;

a sleeve made at least partially of corrugated plastic having vertically extending

corrugations defining a plurality of flutes, the sleeve being secured to the pallet base with fasteners extending through the flutes of the sleeve; and

a frame secured to opposed sides of the sleeve, the frame defining an opening on a fourth side of the horizontal dispensing container, whereby the frame has an open interior to provide horizontal access to product residing in the interior of the container.

Claim 57. (Previously Presented) The container of claim 56 further comprising dunnage inside the container.

Claim 58. (Previously Presented) The container of claim 57 wherein the dunnage comprises intersecting partitions.

Claim 59. (Previously Presented) The container of claim 57 wherein the dunnage comprises pouches.

Claim 60. (Previously Presented) The container of claim 57 further comprising a brace extending between opposed sides of the sleeve.

Claim 61. (Previously Presented) A stackable horizontal dispensing container comprising:
a pallet base;

a sleeve made at least partially of corrugated plastic having vertically extending

corrugations defining a plurality of flutes, the sleeve being secured to the pallet base with fasteners extending through the flutes of the sleeve; and

a metal frame secured to opposed sides of the sleeve with fasteners, the metal frame defining an opening on a fourth side of the horizontal dispensing container, whereby the frame has an open interior to provide horizontal access to product residing in the interior of the container.

Claim 62. (Previously Presented) The container of claim 61 further comprising a brace extending between opposed sides of the sleeve.

IX. EVIDENCE APPENDIX: (S/N 10/761,013)

Appellant relies on no additional evidence.

X. RELATED PROCEEDINGS APPENDIX: (S/N 10/761,013)

None